

Claims 1-6, 8, 10-33, 35, 37, 39-58, 60, 61, 63, and 65-68 were rejected under 35 U.S.C. § 103(a) as being obvious from "ISBN 0-439-20822" (hereafter "ISBN").

Claim 39 was rejected under 35 U.S.C. § 103(a) as being obvious from ISBN in view of Phelps U.S. Patent No. 3,217,866 (hereafter "Phelps").

Applicants Reply
to the Final Rejections under 35 U.S.C. § 103(a)

Applicants' invention is that of a book having a theme and capable of displaying coins. Coins are displayed in applicants' invention by means of coin receivable apertures defined in at least one of the book's covers. Additionally, applicants' invention is tailored to display those coins with the same theme as that of the book's covers, pages, and coin receivable apertures.

Applicants' invention is unique because at least one of the coin receivable apertures is defined on the exterior of at least one of the book's covers. As a result, coins may be displayed and manipulated even after the book is closed. Furthermore, applicants' invention provides utility even when coins are not placed in the apertures by incorporating theme-related pre-printed information on the book's pages. This information may be, for example, a story about an image depicted on a specific coin. In preferred embodiments of applicants' invention, only a small number of coin receivable apertures are included.

It should be noted that coin displays and coin holding folders are well known in the art and may be used to store a large number of coins for collecting purposes. These prior art folders protect coins when closed and display them when open.

ISBN is a prior art folder that may store the entire collection of fifty state quarters. These quarters

may be stored in coin receivable apertures that are defined in plastic sheets attached to the interior of the folder. These plastic sheets are transparent and placed on the interior of the folder in such a manner that the apertures align with coin names illustrated on the interior. As a result, the coin names appear to be located in the coin receivable apertures. Additionally, a pamphlet is discussed by ISBN, but it is not directly attached to the folder.

Phelps is a prior art coin collecting book that may be used to store unrelated coins. Phelps discusses pages attached to and between the book's covers in which coin receivable apertures are defined.

The Examiner argued, in regards to claims 34 and 59, that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the aperture at any desirable location on the cover, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse* 86 USPQ 70" (Examiners' Action, page 4).

In a prior communication, applicants cancelled claims 34 and 59 and the subject matter of these claims was amended into independent claims 1 and 44. For this reason, applicants assume that the Examiner's rejection of claims 24 and 59 now applies to claims 1 and 44. Applicants' arguments below traverse these outstanding rejections.

In regards to claims 1 and 44, applicants' invention teaches a coin displaying book with at least one or more coin receivable apertures located on the exterior of at least one of its covers (Applicants' Spec., FIGS. 1 and 4). As a result, coins may be displayed, removed, and placed in these exterior apertures even after the book is closed.

ISBN does not discuss defining apertures in at least one of the covers, as suggested by the Examiner.

Instead, ISBN teaches a transparent piece of plastic that is attached to the cover's interior and in which coin receivable apertures are defined.

None of the prior art discusses a folder, let alone a book, in which coin receivable apertures are defined in the exterior of at least one of the covers. These prior art folders only define the coin receivable apertures on the interior of the covers or pages located between them. Therefore, when these prior art displays are closed, the apertures may not be displayed and coins may not subsequently be removed, placed, or displayed in them. For these reasons, the prior art pertains more specifically to a way of storing and collecting coins, not displaying them as taught by applicants' invention.

Furthermore, while *In re Japikse*, 86 USPQ 70 (1950) states there is no invention in shifting a component to a different position only if "the operation of the device would not thereby be modified" (*Id.* at 73), applicants have shown above that the operation of a folder or book would be modified if the coin receivable apertures were moved from the interior of a cover to the exterior of one. For at least the above reasons, claims 1 and 44 are allowable because the prior art does not show or suggest placing the coin receivable apertures in the exterior of at least one of the covers. Since claims 1 and 44 are allowable, claims 2-43 and 45-68 are also allowable because they depend on claims 1 and 44.

To aid the Examiner in visualizing what applicants regard as their invention, Exhibit A has been attached to the end of this Reply. Exhibit A is a photocopy of one embodiment of applicants' invention. Specifically, Exhibit A is a Sacagawea dollar coin displaying book with the theme of a Sacagawea dollar coin. Some elements of Exhibit A are described below:

Page 1 of Exhibit A illustrates the first book cover in which two coin receivable apertures are defined. The book theme is present inside each coin receivable aperture in the form of a life-size image of one side of a Sacagawea dollar. Also, the book theme is present on the front cover in the form of a Sacagawea portrait.

Pages 2 to 29 of Exhibit A show the importance of the pre-printed information contained on the pages of the book. These pages are also associated with the book's theme. Pages 6-25 contain pre-printed information telling the story of Sacagawea. Pages 26 and 27 contain pre-printed information describing the history of the Sacagawea coin as well as details pertaining to the coin's production.

The final rejections of claims under 35 U.S.C. § 103(a) are traversed.

Applicants Reply to Examiner's Comments

The Examiner commented that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the aperture at any desirable location on the cover (whether it is inside or outside the cover), since it has been held that rearranging parts of an invention involves only routine skill in the art" (*In re Japikse*, 86 USPQ 70 (1950)). However, it is well settled that the mere fact that the prior art could be modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

With respect to the field of the present invention, coin collecting devices have been around for hundreds of years and have been developed in order to protect and preserve valuable coins from the effects of

weather, time, dust, and light. As a result, a majority of the prior art involves encasing the coins in some form in order to preserve and protect coins. One of the more common devices used to encase coins has been a coin collecting book, in which the coins are stored in interior cover apertures and protected only after the book is closed.

Applicants' claimed invention is different from any of the prior art coin collecting books because it is a coin displaying book. In shifting the apertures to the exterior of the book, the operation of the coin display book is different from that of the prior art. The prior art protects -- the invention displays.

Applicants respectfully submit that the Examiner may have missed a critical element from the *In re Japikse* holding. Specifically, the Examiner states that "rearranging parts of an invention involves only routine skill in the art." This cited quote is misleading because it was not made by the Appeal Board, but by the Primary Examiner during prosecution of the case. Particularly, the Primary Examiner in *In re Japikse* states that "the relocation of Cannon's switch A-42 so that it may be operated by beaver tale 62 instead of by dog A-2 is devoid of invention" (*In re Japikse*, 86 USPQ 74).

The Appeal Board, however, holds that "there would be no invention in shifting the starting switch disclosed by Cannon to a different position since the operation of the device would not thereby be modified" (*In re Japikse*, 86 USPQ 73). For this reason, the Appeal Board holds that if the operation of a device is modified by shifting one or more of its components, then a unique and novel invention would exist.

According to the principles of *In re Japikse*, if the operation of a coin book changes as a result of a shifting of these coin receivable apertures then a unique

and novel invention would exist. Moving the apertures to the exterior of the cover eliminates the need for opening the book in order to view the coins. Thus, this claimed element distinguishes the operation of applicants' coin display book from the prior art. The coins may be seen without opening the coin book and may provide insight into the theme of the pre-printed information inside the book. This modification is not obvious because the prior art does not suggest the desirability of the modification. In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). For at least the above reasons, independent claims 1 and 44, and claims dependent thereof, are allowable.

Additional Comments by the Applicants

As mentioned above, applicants' invention is displays coins that have the same theme as the theme of the book's covers, pages, and coin receivable apertures. As a result, applicants' claimed invention provides utility even when coins are not placed in the apertures by incorporating theme-related pre-printed information on the book's pages. This information may be, for example, a story about an image depicted on a specific coin.

The Examiner argued, that "it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability" *In re Gulack*, 217 USPQ 401 (Examiner's Action, page 4). However, applicants use of the pre-printed information increases the utility of coin-receivable displays when coins are not stored because the claimed pre-printed information is related to the claimed theme of both the book coin display and the coin itself. See *In re Dembiczak*, 175 F.3d 994 (C.A. Fed. 1999) (placing images associated with Halloween-style pumpkins, or jack-o'-lanterns, were found patentable when placed on

garbage bags); *See McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 60 USPQ2d 1001 (C.A. Fed. 2001) (placing unique finger-print associated images on baseballs were found patentable).

Conclusion

Applicants have demonstrated the claimed subject matter is in condition for allowance.

An early and favorable action is respectfully requested.

Respectfully submitted,



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